

REMARKS

Claims 1-5 and 7-10 remain in the application. Claims 6 and 11 have been previously cancelled. Claims 1, 7, and 8 have been amended. Claim 1 is in independent form.

The specification has been amended to clarify terminology set forth originally in the application as filed. Applicants attest that no new matter has been added thereto.

The Examiner has objected to the claims due to certain informalities therein. More specifically, the Examiner has objected to claims 1 and 8, stating that it is unclear whether the "release lever" in claim 1 is also the "manual release lever" in claim 8. In response, Applicants have amended claim 8 to set forth a manual release in place of the manual release lever. Support for a manual release is found in the specification at page 10, line 6, which states, "[e]ach manual release 18, 34 functions independently and each holds the pawl 52 in the releasing direction as long as the manual release 18 or 34 is held in an actuated position by the person opening the door 12." Thus, the manual release as set forth in claim 8, as amended, is different from the release lever set forth in claim 1.

The Examiner has also objected to claim 7, stating that the drawings never show the ratchet 50 contacting the second switch 78 and that it appears the ratchet only contacts the first switch 76. In response, Applicants have amended claim 7 to clarify that the ratchet includes a cam surface disposed for engagement with the *first* switch when the ratchet is disposed in the closed position. In light of the amendments to the claims set forth above, Applicants respectfully request that the objections to the claims be withdrawn.

The Examiner has rejected claims 1-5 and 7-10 under 35 U.S.C. §103(a) as being unpatentable over United States Patent 4,763,936 ("the '936 reference") to Rogakos in view of United States Patent 5,992,194 ("the 194 reference") to Baukholt, and further in view of United

States Patent 5,137,311 ("the '311 reference") to Brackmann. Applicants respectfully traverse this rejection.

The '936 reference teaches a power operated door latch including power operating means that power rotate a fork bolt from an ajar-latched position to a closed-latched position, and that powers movement of a detent lever to a releasing position in order to release a fork bolt for releasing a striker. The '936 reference utilizes switches to initiate powered closing and release of the fork bolt. The '194 reference teaches a ratchet contacting a switch when the ratchet reaches its closed position to turn off a motor. And the '311 reference teaches a lever contacting one switch when a trunk is partially shut to start a motor, and a cam contacting another switch when the trunk is completely closed to stop the motor.

The power door latch assembly of the above-captioned application includes ratchet, a pawl, a rotary actuator, a drive actuator, a drive controller, a release lever, a first switch for selectively operating a clutch when the ratchet is disposed in a closed position and a second switch for starting operation of a prime mover wherein the second switch is actuated by an arm of the release lever only when the pawl engages a detent surface of the ratchet. The cited references do not provide a single power door latch assembly that includes both a release lever coupled to a pawl for contacting a switch when a ratchet is in the partially open position to start a motor, and the same ratchet contacting the first switch after the ratchet has moved from its partially open position to its closed position to turn off the motor.

The Federal Circuit has repeatedly stated that, "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Andros*, 28 U.S.P.Q.2D (BNA) 1146 (Fed. Cir. 1993); *In re Geiger*, 815 F.2d 686 (Fed. Cir. 1987); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed. Cir. 1984). Or, put another way, "[t]he references

themselves must provide some teaching whereby the applicant's combination would have been obvious." *In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991).

Applicants contend that there is no teaching, suggestion, or incentive to combine the cited references in order to render the subject matter of the claims in the above-captioned application obvious to a person having ordinary skill in the art at the time the invention was made. The '936 reference *already* discloses using a switch to start and stop powered movement of a bolt from an ajar-latched position to a closed-latched position, and from a closed-latched position to an open position. Thus, Applicants cannot fathom how one skilled in the art would have any incentive to combine the '311 reference with the '936 reference. Further, it is even more difficult to comprehend how one skilled in the art would have had the incentive to combine the '936 reference with both the '194 reference *and* the '311 reference to produce the subject matter of the claimed invention. Moreover, none of the cited references themselves suggest such a combination.

35 U.S.C. §103(a) states that a patent may not be obtained if "the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious...." As the Federal Circuit has succinctly stated:

[t]he "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A+B+C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning... would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270 (Fed. Cir. 2004).

Applicants contend that the Examiner has improperly applied hindsight in combining the cited references. Applicants fail to see how the three references cited by the Examiner provide any teaching, suggestion, or motivation of the Applicants' invention; rather, it appears as though the Examiner used the above-captioned application as a blueprint or roadmap for finding its various elements in the prior art. Thus, the Examiner has improperly reached into each reference and pulled

out elements without giving consideration to the claimed invention *as a whole*. Such reconstructive hindsight is an improper method for finding motivation in the prior art.

Looking at the cited references, there is nothing that suggests the desirability of their combination. Thus, Applicants believe that one of ordinary skill in the art would not have had the motivation to combine these three references to come up with the combination of features disclosed in the claimed invention. As a result, Applicants contend that the claimed invention would not have been obvious to one skilled in the art at the time of invention.

Therefore, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) of claims 1-5 and 7-10 as being unpatentable over the '936 reference in view of the '194 reference, and further in view of the '311 reference be withdrawn.

It is respectfully submitted that this patent application is in condition for allowance, which allowance is respectfully solicited. If the Examiner has any questions regarding this amendment or the patent application, the Examiner is invited to contact the undersigned.

The Commissioner is hereby authorized to charge any additional fee associated with this Communication to Deposit Account No. 50-1759. A duplicate of this form is attached.

Respectfully submitted,



Robin W. Asher, Reg. No. 41,590
Clark Hill PLC
500 Woodward Avenue, Suite 3500
Detroit, MI 48226-3435
(313) 965-8300

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